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DATE: June 21, 2004
TO: Examiner Hung V. Ngo, Group Art Unit 2831
COMPANY: United States Patent and Trademark Office
FAX NUMBER: (703) 872-9306

FROM: Michael P. Noonan
TELEPHONE NUMBER: (512) 996-6839
FAX NUMBER: (512) 996-6853

NUMBER OF PAGES, INCLUDING COVERSHEET: 16

MESSAGE

Enclosed is a Reply Brief in Response to the Examiner's Answer, in triplicate.
Serial No. 09/928,737 (Attorney Docket SC09785T CD1 Quan)

- ☐ FREESCALE SEMICONDUCTOR ATTORNEY-CLIENT PRIVILEGED/WORK PRODUCT
- ☐ FREESCALE SEMICONDUCTOR GENERAL BUSINESS
- ☐ FREESCALE SEMICONDUCTOR INTERNAL USE ONLY
- ☐ FREESCALE SEMICONDUCTOR CONFIDENTIAL PROPRIETARY

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANT(S) Son K. Quan *et al.* GROUP ART UNIT: 2831
APPLN. NO.: 09/928,737 EXAMINER: Hung V. Ngo
FILED: August 13, 2001
TITLE: SEMICONDUCTOR PACKAGE AND METHOD THEREFOR

CERTIFICATE OF TRANSMISSION UNDER 37 CFR 1.8

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to the Patent and Trademark Office.

on June 21, 2004
Patricia Parks
Patricia Parks

REPLY BRIEF IN RESPONSE TO THE EXAMINER'S ANSWER

Commissioner for Patents
Alexandria, VA 22313-1450

Board of Patent Appeals & Interferences:

This Reply is filed pursuant to 37 C.F.R. §1.193 in the matter of the Appeal to the Board of Appeals and Interferences of the rejection of the claims of the above-referenced application for patent. This Reply is submitted in response to the Examiner's Answer dated April 20, 2004, and within the time limit for response to same, said time limit ending June 21, 2004 (June 20, 2004 being a Sunday).

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REPLY TO EXAMINER'S GROUPING OF CLAIMS

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REPLY TO EXAMINER'S ARGUMENTS

New Point of Argument Raised by the Examiner's Answer

The Examiner's Answer raises at least a first new point of argument. Specifically, the Examiner newly cites Lin '193 for the proposition that overmolding is a type of one-sided encapsulation, and then argues thereupon that Tuttle '513 uses one-sided encapsulation. The Examiner appears to be saying that Tuttle preempts the appealed claims to the extent the appealed claims require overmolding, regardless of whether Tuttle teaches or discloses an overmolding type of one-sided encapsulation, merely because Tuttle discloses one-sided encapsulation.

Response to Examiner's New Point of Argument

Appellants respectfully submit that the foregoing is a new grounds of rejection, and by itself constitutes sufficient basis to reopen prosecution. Moreover, Applicants respectfully disagree that (i) the statement that overmolding falls into a class of one-sided encapsulation, and (ii) the citation of a reference which allegedly also discloses a one-sided encapsulation, are sufficient to reject Appellants' claims which require

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overmolding, another type of one-sided encapsulation. After all, Appellants do not purport to cover *all* one-sided encapsulation techniques, but only those in which overmolding is used as recited by claim 17. There may well be other one-sided encapsulation techniques outside the scope of the claimed invention, and Tuttle is one of those techniques. As such, the cited teachings of Tuttle do not provide sufficient basis for rejection of claims 17-21 under 35 U.S.C. § 102.

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The Examiner's Answer raises at least a second new point of argument. Specifically, in response to the Appellants' argument (as characterized by the Examiner) that the Examiner failed to show sawing through a molded encapsulation material for singulation purposes (See Examiner's Answer, pages 5-6), the Examiner argues that "cutting is *equivalent* to sawing and Tuttle discloses individual circuits can be singulated by cutting." (Examiner's Answer, page 7 (emphasis supplied).)

Response to Examiner's New Point of Argument

Appellants respectfully submit that cutting and sawing are not equivalent. It is possible that devices may be singulated by cutting without sawing, and by sawing without cutting. Thus, the cutting of Tuttle is insufficient to reject claim 21 under 35 USC § 102. Moreover, the mere assertion of such equivalence does not provide a *prima facie* case of unpatentability. This is especially apparent when one considers that "equivalence" is not the standard for a rejection under 35 USC § 102. The invention itself must be described. If the Office wishes to maintain that the cutting of Tuttle is the same as the sawing of claim 21, Appellants request that the Examiner provide at least some evidence of such identity. Since neither evidence nor official notice have been provided, Appellants respectfully request that this equivalence-based rejection be withdrawn.

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Appellants respectfully submit that the "substantially flat top surface" of Tuttle does not suggest, by itself, the use of automated equipment to pick and place the enclosed circuits. The Examiner's assertion does not refute Appellants' arguments offered earlier in prosecution and during this appeal. If the Office wishes to maintain that the "substantially flat top surface" of Tuttle, by itself, without evidence, makes the use of automated equipment obvious, Appellants request that the Examiner provide at least one reference of such obviousness. Since neither evidence nor official notice have been provided, Appellants respectfully request that this rejection be withdrawn.

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CONCLUSION

Appellants respectfully request that the rejection of the appealed claims under 35 U.S.C. 103(a) be reversed by the Board for the reasons stated above and in the Appellants' Appeal Brief.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Michael P. Noonan', with a long horizontal flourish extending to the right.

Michael P. Noonan
Attorney for Appellants
Registration No. 42,038
Telephone No. (512) 996-6835

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